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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,055	10/11/2001	Takeshi Shimizu	028918.01	7629

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/974,055

Applicant(s)

SHIMIZU ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: application filed on 10/11/01 which is a continuation of the application 08/938,973 filed on 9/26/97, now US Pat No. 6,374,271.

2. Claims 1-14 are pending in the case. Claims 1, 6, 10, 13 are the independent claims.

Claim Objections

3. Claims 10-12 are objected to because of the following informalities:
Regarding independent claim 10, a word after "the" in the phrase "...based on the and the data" (claim 10, line 4) is missing.

Claims 11-12 are also rejected as being dependent on claim 10.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3, 6-7, 10-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 20-22 of U.S. Patent No. 6,374,271. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

'271 discloses:

- a user interface
- a memory
- a controller coupled to the user interface and the memory, wherein the controller links the goals outline and the presentation outline of the document together based on the input received through the user interface and data stored in the memory
- wherein the user interface includes a display device, the controller displaying the goals outline display on the display device and generating the goals outline based on the input that relates to the goal outline display
- wherein the memory contains at least one document prototype, the controller generating a logical structure of the goals outline by instantiating the document prototype selected by the input
- storing data in a memory
- receiving an input through a user interface

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- linking the goals outline to the document presentation outline based on the input and the data
- receiving external information by the controller
- generating a card based on the external information
- generating the imported card by the external information already in the desired card structure
- generating the imported card by translating the external information when the external information is not in the desired card structure
- displaying on the display device a meta-level display of the goals outline and the presentation outline

'271 does not disclose:

- partially author the document
- the goals outline comprises information content of the document and the presentation outline comprises appearance characteristics of the document

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified '271 to include partially author the document, the goals outline comprises information content of the document and the presentation outline comprises appearance characteristics of the document because of the following reasons. The preamble of the claims in '271 discloses a document authoring device.

This suggests authoring documents.

'271 also discloses that a *logical structure of the goals outline* is generated by *instantiating the document prototype selected by the input* (as mentioned above). This

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suggests that the information content of the document is included in the goal outline since the document prototype selected by the input is merely the information of a document.

Further, the presentation outline, by itself, suggests a summary of *how a document looks like*. In other words, it is *appearance characteristics* of the document.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al. (US Pat No. 6,029,182, 2/22/00, 10/4/96).

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Regarding independent claim 1, Nehab discloses:

- a user interface (col 4, lines 40-57)
- a memory (abstract, col 4, lines 30-35)
- a goal outline (figure 9B and col 16, lines 4-21, the container 87, which includes a URL list of information content for a web page where the data for the web page can be arranged in such a order or can be rearranged)
- a presentation outline (the various layout formats of personized documents (col 3, lines 15-32, 45-49))
- a linking between the goal outline and the presentation outline to create a document based on user inputs (link the layout format and the data to create personalized documents (col 3, lines 50 to col 4, lines 1-39))
- authoring a document (create and edit a document (abstract; col 3, lines 15 to col 4, lines 1-12, 40-45; col 8, lines 10-18))

Nehab does not explicitly disclose that the document authoring device comprises a controller coupled to the user interface and the memory that links the goal outline and the presentation outline. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nehab to include a controller coupled to the user interface and the memory that links the goal outline and the presentation outline because of the following reason. Nehab links the data from the web sites included in the container content and the layout formats to create a web document where the linking is performed on a user interface (col 3, lines 50 to col 4, lines 1-39). This suggests that the user interface, the memory for storing data location

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and format commands, the container content, and the WebFormatter are connected together to form a web document. In other words, a unit performing the same function as that of a controller is included in Nehab.

Regarding claim 2, which is dependent on claim 1, Nehab discloses that the user interface includes a display device, the controller displaying the goal outline display on the display device and generating the goal outline based on the input that relates to the goals outline display (col 3, lines 15-32, 50-65; col 4, lines 1-12, 40-45; figure 9B).

Regarding claim 3, which is dependent on claim 2, Nehab discloses:

- document prototype stored in the memory (col 8, lines 10-18, document templates store the formats of documents)
- instantiating the document prototype based on the input (user specifies a desired template (col 8, lines 10-18; col 4, lines 40-45))

Regarding claims 4 and 5, Nehab discloses linking between the document prototype to the card in the memory selected by the input, and generating a card and linking the card to the goals outline based on the input (col 3, lines 15-67 to col 4, lines 1-45, linking between the layout format and the data selected by the input for formatting a document).

Nehab does not use the same terminology: a card contained in the memory to store data information. However, as disclosed in the specification of the invention, a card is

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merely where to store data (page 5, lines 29-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nehab to include the cards for storing data contained in a memory since the web sites storing information data for creating documents in Nehab (col 4, lines 15-32) suggests the card database in the memory.

Regarding independent claim 6, Nehab discloses:

- storing data in a memory (abstract, col 4, lines 30-35)
- receiving an input through a user interface (col 4, lines 40-45; col 9, lines 62 to col 10, lines 1-6; figure 9A, col 14, lines 6-18)
- linking the goals outline to the document presentation outline based on the input and the data to at least partially author the document, wherein the document goals outline comprises information content and the document presentation outline comprises appearance characteristics

Nehab does not explicitly disclose linking the goals outline to the document presentation outline based on the input and the data to at least partially author the document, wherein the document goals outline comprises information content and the document presentation outline comprises appearance characteristics.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nehab to include linking the goals outline to the document presentation outline based on the input and the data to at least partially author the document, wherein the document goals outline comprises information

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content and the document presentation outline comprises appearance characteristic because of the following reason. Nehab links the data from the web sites included in the container content and the layout formats to create a web document where the linking is performed on a user interface (col 3, lines 50 to col 4, lines 1-39). This suggests that the content information and the appearance of the data are linked together to create a web document.

Regarding claim 7, which is dependent on claim 6, Nehab discloses displaying a goals outline display on a display device and generating the goals outline based on the input that relates to the goals outline display (col 3, lines 15-32, 50-65; col 4, lines 1-12, 40-45; figure 9B).

Regarding claim 8, which is dependent on claim 7, Nehab discloses:

- generating a logical structure of the goals outline by instantiating a document prototype selected by the input (col 8, lines 10-18, document templates store the formats of documents)
- linking the instantiated document prototype to a card selected by the input (col 8, lines 10-18; col 4, lines 40-45)

Regarding claim 9, which is dependent on claim 8, Nehab does not disclose:

- generating a card
- linking the card to the goals outline based on the input

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Nehab, instead, discloses linking between the data in the URLs list selected by the input and the logical structure of a document for formatting a document (col 3, lines 15 to col 4, lines 1-45, figure 9B, data stored in the URLs listed in the container content).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nehab to include generating a card and linking the card to the goals outline based on the input because of the following reason. As disclosed in the specification, a card is merely where to store data (page 5, lines 29-33). Therefore, the data, which is stored in a URL, is considered as equivalent to a card, is linked to the logical structure of the document (figure 9B, the multiple column of the document is selected for generating a document).

Independent claim 10 includes the same limitations as that of independent claim 6, and is rejected under the same rationale. Independent claim 10 further includes:

- receiving external information by the controller
- generating a card based on the external information
- storing the card as data in the memory

As mentioned above in independent claim 6, Nehab discloses receiving an input through a user interface (col 4, lines 40-45, col 9, lines 62 to col 10, lines 1-6; figure 9A, col 14, lines 6-18, data included in a formatted web document is received as a user input in the URL field on the user interface).

Nehab also discloses generating a card based on the external information (col 3, lines 15 to col 4, lines 1-45, format the data for a personalized document based on a user

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defined formatting commands where the commands are considered as external information entered by the user).

Nehab does not disclose storing the card in the memory. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated the storing step into Nehab since it was well known in the art that the data after created should be stored in a memory for later use.

Regarding claims 11 and 12, which are dependent on claim 10, Nehab discloses:

- generating an imported card step accepts the external information already in a desired card structure as the imported card (col 3, lines 30-49, the data from the web sites and the stored format information is applied for formatting a personalized document)
- generating an imported card step translates the external information into a desired card structure (col 3, lines 50-65, formatting a personalized document based on the data from the *user defined* Web site address information, *user defined* Web site commands and *user defined formatting commands* implies that data from the external information is not in a desired format and so said data needs to be translated into a desired form based on the user defined formatting commands)

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9. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewer et al. (US Pat No. 5,347,628, 9/13/94).

Regarding independent claim 13, Brewer discloses:

- receiving inputs through a user interface (abstract, figure 2, col 3, lines 62-67)
- displaying on the display device a meta-level display (figures 1-3; col 3, lines 28-39; col 4, lines 1-20, an electronic office is a meta-level display wherein the calendar icon 23 is a goal outline, the desktop icon 19 is a presentation outline, and the drawer icon 17 is where data is stored).

Brewer does not disclose explicitly linking a goal outline to a presentation outline based on the input and the data. Instead Brewer discloses the logical structure of the whole image of the office such as an office includes a desk and a cabinet where the desk includes drawers, the desktop includes an in/out basket and a calendar, and the cabinet includes drawers and shows how the items (desk, cabinet) are placed in the office (the cabinet is in the corner and on the right side of the desk, the calendar is on the middle of the desktop and the in/out basket is on the right corner of the desktop (figures 1-3). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Brewer to include the goal outline and the presentation outline and the linking between them because of the following reason. The logical structure of the office image suggests the goal outline for creating such an image file and the layout of the office as seen in the figures suggests a presentation outline for an image file.

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Further, Brewer does not explicitly disclose the storing of data in the memory. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Brewer to include storing data in the memory since by convention, data when created should be stored in a memory for later use.

Regarding claim 14, Brewer discloses that the meta-level display is one of a kitchen image, an office image, and a studio image (figure 2, this is an office image includes a meta-level display of an office-desk-drawer display).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Liu et al. (US Pat No. 6,321,244 B1, 11/20/01, 12/4/97).

Young (US Pat No. 6,117,933 B1, 1/23/01, 11/26/97).

Ross et al. (US Pat No. 6,026,417, 2/15/00, 5/2/97).

Mahoney et al. (US Pat No. 5,999,664, 12/7/99, 11/14/97).

Andersen et al. (US Pat No. 5,903,905, 5/11/99, 4/30/96).

Jack et al. (US Pat No. 5,119,465, 6/2/92, 6/19/89).

Kelly et al. (US Pat No. 5,173,853, 12/22/92, 5/14/91, priority 5/14/90).

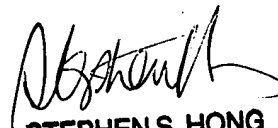
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 707-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
May 3, 2002


STEPHEN S. HONG
PRIMARY EXAMINER